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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,365	09/08/2003	Anthony J. Baerlocher	0112300-1424	9501
29159	7590	10/10/2007	EXAMINER	
BELL, BOYD & LLOYD LLP			HARPER, TRAMAR YONG	
P.O. Box 1135			ART UNIT	PAPER NUMBER
CHICAGO, IL 60690			3714	
			NOTIFICATION DATE	DELIVERY MODE
			10/10/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

Office Action Summary

Application No.

10/657,365

Applicant(s)

BAERLOCHER, ANTHONY J.

Examiner

Tramar Harper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/25/05, 2/4/05, 8/24/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24 & 31-40, drawn to a gaming device comprising a plurality of different level selections wherein the selections consist of pay (pay outcome with count against pick counter), advance (move to next level with count against pick counter), repeat (pick from same level with count against pick counter), and pass (move to next level without count against pick counter) outcomes. A player is given a predetermined amount of picks that the player uses throughout the each level. The player picks and accumulates respective awards until the player exhausts all of the available picks throughout each subsequent level until the final level.
- II. Claims 25-30 & 41-43, drawn to a gaming device comprising a plurality of different level selections wherein the selections consist of pay (pay outcome with count against pick counter), advance (move to next level with count against pick counter), repeat (pick from same level with count against pick counter), and pass (move to next level without count against pick counter) outcomes. A player is given a predetermined amount of picks that the player uses throughout the each level. The player picks and accumulates respective awards until the player exhausts all of the available picks. Furthermore, if a player has available picks the gaming

device has a return function that enables a player to pick again from a previous level of a "advance" or "skip" pick.

Inventions of groups 1 and 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination as claimed requires a gaming device comprising a plurality of different level selections wherein the selections consist of pay (pay outcome with count against pick counter), advance (move to next level with count against pick counter), repeat (pick from same level with count against pick counter), and pass (move to next level without count against pick counter) outcomes. A player is given a predetermined amount of picks that the player uses throughout the each level. The player picks and accumulates respective awards until the player exhausts all of the available picks. Simply put a player exhausts picks while progressing through each level. The player picks and accumulates respective awards until the player exhausts all of the available picks throughout each subsequent level until the final level. The subcombination has separate utility such as if a player has available picks the gaming device has a return function that enables a player to pick again from a previous level of a "advance" or "skip" pick.

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The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Adam H. Masia on 10/01/07 a provisional election was made without traverse to prosecute the invention of Group 1, claim 1-24 & 31-40. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-30 & 41-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 16-24 objected to because of the following informalities: Examiner believes applicant intended for the Claims to be dependent of Claim 15 rather than 14. Appropriate correction is required.

Claim 13 objected to because of the following informalities: Examiner believes applicant intended for the Claim to be dependent of Claim 12 rather than 11. Appropriate correction is required.

Claim 23 objected to because of the following informalities: Examiner believes applicant intended for the Claim to be dependent of Claim 22 rather than 21. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-15, 17-24, & 31-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Cregan et al (US 7,273,415).

Claims 1, 15, 31-32, 34, & 36-37: Cregan discloses a gaming device that comprises of a plurality of different levels of selections wherein a player is given a predetermined amount of picks to pick selections of the different levels. The player uses these picks throughout each level, including a final level, until the picks are exhausted. The picks

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include a first result/pick or "pay symbol" which includes a pay outcome and a count against the number of picks, a second result or "advance symbol" which includes a move to a next selection level and a count against the pick counter, a third result/pick which includes a "repeat pick" wherein a player can pick from the same selection level more than once which also includes a count against the pick counter, and a forth result/pick which includes a "skip pick" (Col. 15:62-64) which involves a move to a next level without a count against the pick counter. After each pick the award or outcome is revealed to the player. After a player has exhausted the available picks the player obtains or accumulates the total awards (Col. 14:58-Col. 16:59).

Claims 3 & 17: Cregan further discloses a final level which includes at least one first/pay outcome associated with at least one pick within the final level (see above).

Claims 4, 18, & 33: Cregan discloses that a player picks from the same level until picking an advance indicator e.g. a player can repeat picks up to as many times as the allotted picks allow until picking an advance indicator (see above). This also encompasses the player picking from a selection level at least twice and repeating the process in the next next level.

Claim 5: Cregan discloses that the final selection level can include multiple selections, therefore, if a third result occurs wherein a player picks from the final selection group and the player has more picks available then the player can place an additional pick within the final selection group. This encompasses an additional pick made available only after the player has pick from each selection group considering that the player has

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to at least make one pick in order to reach the final selection group (Col. 15:58-60 and above).

Claims 6-11, 19-21, 35, & 38: Cregan discloses that the advance indicator furthermore can provide an additional award to the player (Col. 15:30-35). Cregan discloses that average pay outcomes for each subsequent level are increased (Col. 15:12-20).

Furthermore, Cregan discloses that if a player does not pick an advance or skip outcome the player can additionally pick a third result that includes picking an additional award from the same level (see above). Cregan also discloses that the advance/skip indicator includes an additional award/value.

Claims 12-13, 22-23, & 39-40: Cregan discloses the game is provided via a data network through the internet or a computer storage device (Col. 5:58-Col. 6:30).

Claims 14 & 24: Cregan discloses that the controller determines the random positions and values of the picks each time the player plays the bonus round e.g. predetermined before play (Col. 5:50:56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cregan (US 7,273,415) in view Hughs-Baird (US 2003/0045349).

Claim 2 & 16: Cregan discloses the above with respect to claims 1 & 15, but fails to disclose a “stay” type pick that enables a player to pick another pick from the same level without a count against the pick counter. Cregan discloses that the above gaming system is geared towards enhancing the level of player excitement and enjoyment (Col. 2:23-25). Cregan discloses that player enjoyment is enhanced because of the multiple opportunities a player has at achieving game credits (Col. 3:14-17). However, Hughs-Baird discloses a similar award selection game wherein a player is given a predetermined number of picks to pick and accumulate various awards (Abstract). Hughs-Baird discloses a “pick again” pick, which enables a player to make an additional pick without a count against the pick counter (§ 58). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system of Cregan with the “pick gain” option of Hughs-Baird to provide a further incentive for the player to play the game. Such a modification would increase the opportunities a player has to achieve an award and therefore enhance the level of excitement and enjoyment.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baerlocher (US 6,786,819), Maya (2004/0082374), Souza (US 2005/0054419), Hughs-Baird (US 7,182,689), Glavich (US 2002/0045475), Baerlocher (US 2003/0153383), Kaminkow (US 2003/0078096), Kaminkow (US 6,511,375), & Cuddy (US 2003/0060254) all teach a similarly structured game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tramar Harper whose telephone number is (571) 272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Ronald Laneau
Primary Patent Examiner
Art Unit 3714

TH

10/01/07